REMARKS

Claims 1-14 are currently pending in this application, with Claims 1 and 9 being independent.

In the Office Action, Claims 1-6, 9, and 12-14 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Eklund* et al. (NPL: IEEE C802.16-02/05 "A Technical Overview of the WirelessMAN™ Air Interface for Broadband Wireless Access").

Claims 7, 8, 10 and 11, are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Eklund* in view of *Mizell* et al. (U.S. Pub. No. 2002/0077097).

Regarding the § 102(b) rejections, Applicants previously argued that "command[ing] a timing advance and a power adjustment" to the subscriber station "*[b]ased on the arrival time of the initial ranging request and the measured power of the signal*" in *Eklund* is not the same as "transmitting state control (timing and power offset adjustment) information *based on a channel state* to the subscriber station" as recited in Claims 1 and 9.

Additionally, Applicants argued that although in *Eklund*, "*during initial access*, the [Subscriber Station] performs initial power leveling and ranging using ranging request (RNG-REQ) messages transmitted in initial maintenance windows," this is not the same as "receiving channel state control information from the base station *in response to the bandwidth request code*" as recited in Claim 9.

In the Final Office Action, the Examiner found the above arguments unpersuasive. Applicants respectfully disagree and maintain the previous arguments. Additionally, Applicants respectfully disagree regarding the Examiner's response to the second argument, i.e. the bandwidth request feature argument. Specifically, the Examiner asserts that *Eklund* discloses, "transmitting state control [information]" as a result of "receiving a bandwidth request code" (Claim 1) or "in response to the bandwidth request code" (Claim 9) because "transmission of state control in the

ranging response from the base station is inherently in response to a bandwidth request." (Office Action, page 3). That is, the Examiner is alleging that transmitting state control is inherent to bandwidth requests and because *Eklund* transmits "time advance, as well as power adjustments [i.e. state control]," state control is necessarily transmitted because of the bandwidth request. However, the Examiner's mere conclusory statement cannot reasonably be said to be a development of any reason supporting the Examiner's reliance on inherency. Therefore, the characterization that the bandwidth request feature is disclosed in *Eklund* because transmitting state control information is inherent to bandwidth requests, is unsupported and thus improper.

According to MPEP § 2112(IV), the Office always bears the initial burden of developing reasons supporting a reliance on inherency. To satisfy this burden, the Office must identify some basis in fact or articulate some reasoning at least tending to show that allegedly inherent subject matter necessarily (i.e., inevitably) flows from cited art. Indeed, MPEP § 2112(IV) states, in part, that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q. 2d 1949, 1950-51 (Fed. Cir. 1999)" *Id.* "'In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.' *Ex parte Levy*, 17 U.S.P.Q. 2d 1461, 1464 (B.P.A.I. 1990)." *Id.*

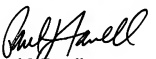
In the present case, a bandwidth request does not "necessarily" flow from transmitting state control information, in *Eklund*. That is, a bandwidth request is not specified in *Eklund*, and a bandwidth request is not always required to transmit state control information nor is state control information transmitted only as a result of a bandwidth request. For instance, in some systems, state control information is transmitted periodically, without a bandwidth request, and in other systems

bandwidth requests do not necessitate state control information. Therefore, a bandwidth request is not inherently necessary for transmitting state control information. As such, *Eklund* does not inherently disclose the bandwidth request feature to the satisfaction of the MPEP. Accordingly, the Examiner has not met his burden to fully develop reasons supporting his reliance on the doctrine of inherency. Thus, *Eklund* fails to anticipate independent Claims 1 and 9 and the rejections should be withdrawn.

For the foregoing reasons, it is believed that independent Claims 1 and 9 are in condition for allowance. Without conceding the patentability *per se* of the dependent claims, they are also believed to be in condition for allowance for at least the above reasons. Accordingly, Applicants believe that all pending claims are allowable over the cited art and rejections should be withdrawn.

Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, it is requested that the Examiner contact Applicants' attorney at the number given below.

Respectfully submitted,



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